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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,545

02/13/2007

Michael Spitz

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7590

06/21/2010

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.

Intellectual Property Department

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EXAMINER

VINH, LAN

ART UNIT

PAPER NUMBER

1713

NOTIFICATION DATE

DELIVERY MODE

06/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/564,545	Applicant(s) SPITZ ET AL.	
	Examiner LAN VINH	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-35 is/are allowed.
- 6) ☒ Claim(s) 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>021307</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 40 is indefinite because it depends on cancelled claim 16. For the purpose of examination, claim 40 is best understood as depending on claim 36

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartels et al (US 5,911,851)

Bartels discloses an atomiser for a fluid, comprising a nozzle arrangement for atomising a fluid (see abstract), the atomizer produces a spray of fine droplets suitable for the administration of a medicament/the atomizer is an inhaler for medical aerosol therapy (col 1, lines 10-15)

Regarding claim 37, Bartels discloses the atomiser comprises a nozzle assembly for

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use in a spray generating device for atomizing fluid/means for effecting atomisation in a purely mechanical manner (col 18, lines 20-22)

Regarding claims 38-39 , Bartels discloses that the atomiser comprises a plenum chamber 65 which contains a fluid (col 13, lines 40-51, figs 16-17), which reads on the atomiser comprises a container which contains a fluid to be atomized wherein the container is movable as a means for generating pressure for producing atomization of the fluid.

The limitation of claim 40 has been discussed above.

It is noted that claim 36 drawn to an apparatus and the recitations of : " for atomizing the fluid that has been produced the method of claim 21" is considered recitations with respect to the manner in which a claimed apparatus is intended to be employed". Since the apparatus taught by Bartels meets all the structural features recited in claim 36 the apparatus taught by Bartels includes the nozzle arrangement would be structurally capable to atomise the fluid that has been produced by the claimed method . It has been held that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844,847, 120 USPQ 528,531 (CCPA 1959). Also, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Apparatus claims cover what a device is, not what a device does." Hewlett-

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Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). CPA 1959).

3. Claims 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by McKay (US 5,666,947)

McKay discloses an atomiser for a fluid, comprising a nozzle arrangement 5 for atomising a fluid (col 4, lines 65-67), the atomizer produces a spray of fine droplets suitable for the administration of a medicament/the atomizer is an inhaler for medical aerosol therapy (col 1, lines 5-8)

Regarding claim 37, McKay discloses the atomiser comprises a atomising nozzle /means for effecting atomisation in a purely mechanical manner (col 2, lines 64-67)

Regarding claims 38-39 , McKay discloses that the atomiser comprises a flexible bladder which contains a fluid (col 3, lines 35-45; fig. 5), which reads on the atomiser comprises a container which contains a fluid to be atomized wherein the container is movable as a means for generating pressure for producing atomization of the fluid.

The limitation of claim 40 has been discussed above

It is noted that claim 36 drawn to an apparatus and the recitations of " for atomizing the fluid that has been produced the method of claim 21" is considered recitation with respect to the manner in which a claimed apparatus is intended to be employed". Since the apparatus taught by McKay meets all the structural features recited in claim 36 the apparatus taught by McKay includes the nozzle arrangement would be structurally capable to atomise the fluid that has been produced by the claimed method . It has

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been held that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844,847, 120 USPQ 528,531 (CCPA 1959). Also, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). CPA 1959).

Allowable Subject Matter

4. Claims 21-35 allowed.

Regarding claim 21, the cited prior art of record fails to disclose or suggest a process for producing a multiplicity of microfluidic arrangements from a plate-shaped composite structure comprised a step of before mechanical machining, at least partially filling the groove structures of the plate-shaped composite structure with a filling medium such that at least openings or portions of the groove structures to be opened by mechanical machining are filled with the filling medium, the filling medium being selected so that it will not be removed from the groove structures either by the mechanical machining itself or by aids used during mechanical machining, in combination with the rest of the steps of claim 21

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAN VINH whose telephone number is (571)272-1471. The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lan Vinh/
Primary Examiner, Art Unit 1713

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